

Application No. 09/781388
Page 5

Amendment
Attorney Docket No. S63.2Q-7132-US02

Remarks

This communication is in response to the Office Action dated December 15, 2004. Claims 47-63 are pending in this application. The Office Action rejected claims 47-63 under 35 USC § 102 over Wand et al. (U.S. Patent No. 5,525,388; hereinafter "Wand"); rejected claims 47-59 and 61-62 in the alternative under 35 USC § 103 over Wand; and rejected at least claims 47, 51 and 60-63 under the judicially created doctrine of obviousness type double patenting.

Reconsideration in view of the following remarks is respectfully requested.

Double Patenting

The Office Action rejected at least claims 47, 51 and 60-63 under the judicially created doctrine of obviousness type double patenting over at least claims 1, 6, 12, 13 and 20-24 of US 6,193,738.

Without forming an opinion as to the validity of the double patenting rejection, Applicants note that the projected expiration date of a patent granted on the immediate application will be the same as the expiration date of the prior '738 patent, regardless of whether or not the immediate application is subject to a Terminal Disclaimer. Therefore, in order to further timely prosecution of the immediate application, a Terminal Disclaimer is enclosed herewith that disclaims the terminal part of any patent granted on the instant application which would extend beyond the expiration date of the '738 patent. Accordingly, Applicants request withdrawal of the rejection under the judicially created doctrine of obviousness type double patenting.

Claim Rejections – 35 USC § 102

The Office Action rejected, under 35 USC § 102, claims 47-63 over Wand. These rejections are traversed.

Applicants assert that Wand does not disclose or suggest a method including "providing a medical balloon," and "removing material from at least one portion of the proximal end and distal end portions of the balloon to a desired reduced thickness," as recited in independent claim 47 and similarly recited in independent claim 60.

Application No. 09/781388
Page 6

Amendment
Attorney Docket No. S63.2Q-7132-US02

Wand discloses a balloon 12 at Figure 4 and a parison 30 or tubular member at Figure 5. Wand states that the parison 30 can be used to form the balloon 12. See column 4, lines 7-8. Thus, the parison of Figure 5 may be modified to produce the balloon of Figure 4. For example, the parison 30 may be blown into a balloon 12 by subjecting the parison 30 to elevated temperatures while inflating the parison 30 with inflation fluid at high pressures within a mold. See column 4, lines 16 – 23.

Wand discloses that “several methods may be utilized to make the tubular parison of the desired size and shape to form the balloon,” and discloses “machining...to form the tapered sections of the parison.” See column 2, lines 45-53.

Applicants assert that the parison disclosed in Wand is not a balloon, and thus, operations performed on the parison do not anticipate the method claims 47 or 60. A person of ordinary skill in the art would understand that a parison is by definition a precursor to a balloon, and that a parison is not capable of functioning as a medical balloon. A parison generally must be blown at high temperatures under high pressures in order to transform into a balloon.

Wand does not mention removing material from a balloon that has already been formed, as described by Applicants at least at page 11, lines 18-20 of the application and recited in independent claims 47 and 60. Therefore, Applicants assert that independent claims 47 and 60 are not anticipated by Wand. Claims 48-59, which depend from independent claim 47, and claims 61-63, which depend from independent claim 60, are not anticipated for at least the reasons discussed with respect to independent claims 47 and 60.

Further, with respect to claims 47-59 and 61-62, the Office Action admits that Wand does not disclose maintaining the temperature of the balloon below a glass transition temperature of the thermoplastic material, as recited in said claims. See Office Action page 3, numbered paragraph 2.

Accordingly, Applicants request withdrawal of the rejections under 35 USC § 102.

Application No. 09/781388
Page 7

Amendment
Attorney Docket No. S63.2Q-7132-US02

Alternative Claim Rejections – 35 USC § 103

The Office Action also rejects, in the alternative, claims 47-59 and 61-62 under 35 USC § 103 over Wand. These rejections are traversed.

As discussed above, Wand does not disclose or suggest removing material from a balloon. Applicants hereby reassert all arguments presented in the discussion of the rejections under 35 USC § 102 with respect to claims 47-59 and 61-62.

Further, as discussed above, the Office Action admits that Wand does not disclose maintaining the temperature of the balloon below a glass transition temperature of the thermoplastic material, as recited in claims 47-59 and 61-62. Wand is the only reference applied by the Examiner. Therefore, the only possible suggestion to perform the claimed material removal operations below a glass transition temperature of the thermoplastic material improperly stems from Applicants' own disclosure and not from the applied prior art. Absent reliance on Applicants' disclosure, there is absolutely no motivation to modify the teachings of Wand to reach the recited claim limitations.

Obviousness cannot be established by a hindsight modification to produce the claimed invention. See *In re Gorman*, 18 USPQ2d 1885 (Fed.Cir.1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the modification. Therefore, Applicants assert that a *prima facie* case of obviousness has not been presented. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 103.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 47-63 are earnestly solicited.

Application No. 09/781388
Page 8

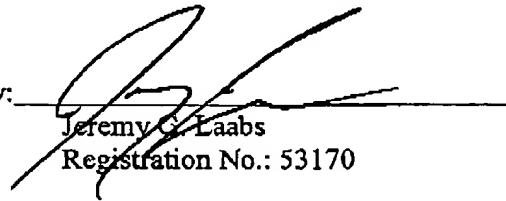
Amendment
Attorney Docket No. S63.2Q-7132-US02

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: March 4, 2005

By: 

Jeremy C. Laabs
Registration No.: 53170

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

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